

the present Response that should overcome some rejections and thus simplify the issues for appeal. Accordingly, Applicants request that the present Response be considered and entered by the Examiner.

## **REMARKS**

**A.      Status of Claims, Changes Made  
to Claims and Support for Such Changes**

Claims 1-4 are pending and added claims 5-38 are pending as of the date of the present Amendment.

Claim 1-38 are not being amended in the present Response.

**B.      Interview with Supervisory Primary Examiner**

The undersigned attorney expresses his appreciation that Supervisory Primary Examiner David Porta granted a personal interview with the undersigned attorney on July 9, 2003. During that interview, the undersigned discussed various issues raised by the Office Action mailed on October 16, 2002. Among the issues discussed were: 1) the appropriateness of making the Office Action Final, 2) format of a Supplemental Reissue Declaration that would overcome rejections based on previous Reissue Declarations and 3) the appropriateness of objections and rejections based on new matter and Section 112, first paragraph.

Regarding the issue of the Supplemental Reissue Declaration, a draft Supplemental Declaration was submitted to Mr. Porta. The draft Supplemental Declaration identified an error in claim 1 for not being broad enough in scope in that claim 1 recites a screw being an actuating element which is not a necessary element. Mr. Porta agreed that this is the type of error that was needed to be recited in order to

overcome the rejections based on the previous Reissue Declarations.

Regarding the objections and rejections based on new matter, the undersigned attorney pointed out that the original specification describes a structure and process where the exterior thread 12 is inserted into an opening. Mr. Porta agreed that the original specification supported the language used in the amendments to the specification made in Applicants' Amendment of February 18, 2003. However, it was his position that the new language was broadening the scope of Applicants' invention and so was new matter.

Regarding the rejections based on Section 112, first paragraph, the undersigned pointed out that language of the claims was supported by the original specification. Mr. Porta agreed that the language was supported by the original specification. However, Mr. Porta pointed out that the scope of the claims was transformed from a turning action to a broader type of action that was so different that the inventions being rejected were not in possession of the inventors. The undersigned pointed out that the original specification had enough disclosure to inform one of ordinary skill in the art that the claims were in possession of the inventors. Mr. Porta disagreed.

### C. Finality of Office Action

Claims 25-29 were not rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251 in the Office Action mailed on October 16, 2002. In the Amendment filed on February 18, 2003, only claim 19 was amended. Now claims 25-29 have been finally rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251. This is improper because Applicants' amendment of claim 19 is not the reason for the

new rejections of claims 25-29 mentioned above. Accordingly, the finality of the rejection should be withdrawn. MPEP § 706.07(a).

**D. Defective Oath**

In the Office Action mailed on April 10, 2003, the reissue oath/declaration was objected to for failing to identify at least one error which is relied upon to support the reissue application. Applicants traverse the objection. Paragraph 7 of the reissue declaration filed on October 29, 2001 states that the inventors believed “that the original ‘940 patent is partly inoperative or invalid by reason of our claiming more or less than we had the right to claim in the patent.” Paragraph 8 of the reissue declaration further asserts that the inventors “believe that our attorney failed to appreciate the full scope of our invention” and new claims 5-38 were being submitted to correct this error. The error recited in paragraphs 7 and 8 is an acceptable basis to rely upon to support a reissue application. *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 372 (Fed. Cir. 1984); MPEP § 1402. Since the Applicants have recited at least one recognized error from which a reissue application can be based, the objection is improper and should be withdrawn.

The undersigned attorney contacted Examiner Le and his supervisor David Porta regarding this rejection during the week of June 30, 2003. Both pointed out that the rejection was based on the failure to specifically one error in the original claims as set forth in MPEP § 1414. It is unclear from this section of the MPEP whether or not Applicants’ recitation of an error based on an attorney’s failure to appreciate the full scope of the invention is sufficient by itself or whether a particular error in a claim must be identified. Out of an abundance of caution, Applicants have assumed for

arguments sake that MPEP § 1414 pertains to the error recited in paragraphs 7 and 8 of Applicants' original Reissue declaration. Accordingly, Applicants are submitting a second Supplemental Declaration that identifies an error in original claim 1. Accordingly, the rejection is overcome and should be withdrawn.

**E. 35 U.S.C. § 132**

Applicants' Amendment filed on February 18, 2003 was objected to under 35 U.S.C. § 132 as containing new matter. In particular, the amendments made to the specification which stated that the exterior thread 12 was inserted into an opening were objected to for containing new matter. The objection stated that only a turning action by the screw was supported by the specification. Applicants traverse this objection. As defined in Webster's Ninth New Collegiate Dictionary, "insert" means "to put or introduce into the body of something." Applicants' patent inherently supports the use of the word "insert" as defined above. In particular, at Col. 2, lines 59-65 it is stated that "the screw 11 is turned into the hollow pick-up shaft 2 until the screw's radially extending surface 14 is supported at a shoulder having a radially extending surface 15 of the pick-up shaft 2." What this means is that surface 14 is originally above surface 15 and turning of the screw 11 causes the surface 14 to move downward until it is supported on surface 15. One of ordinary skill would also understand that during the above described downward movement of the surface 14, the exterior thread 12 of the screw 11 would move downward within the space defined by the interior thread 8. In other words, the lower end of the screw 11 is introduced into portions of the space defined by the interior thread 8 during turning. Since the lower end is introduced into the space, it is by definition "inserted" into the

space.

Since the “insert” language is inherently supported by the original description of U.S. Patent No. 5,981,940, the “insert” language is not new matter under 35 U.S.C. § 132 and so the rejection is improper and should be withdrawn. MPEP § 2163.07(a). Furthermore, the amendments made to the specification in Applicants’ Amendment of February 18, 2003 should be entered.

**F. 35 U.S.C. § 112, First Paragraph**

Claims 19 and 25-29 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that is not described in such a way that would convey that the inventor had possession of the claimed invention. In particular, claim 19 was rejected for reciting an actuating element that is inserted into an opening and relative movement of the actuating element relative to a slit causes the slits to radially spread open. Applicants traverse this rejection. As mentioned above in Section E, Applicants’ patent inherently discloses inserting a portion of the screw 11 into the space defined by interior thread. Furthermore, Col. 2, lines 59-65 of Applicants’ patent describes an insertion process where the screw 11 moves downward. Accordingly, there is support in the original disclosure of the patent for the claim language in question. Since the original description is sufficient to show to one of ordinary skill in that art that the invention of claim 19 was “ready for patenting,” the invention of claim 19 was in possession of the Applicants. MPEP § 2163 I.

There is further evidence that Applicants possessed the invention claimed in claim 19. In particular, claim 1 as granted in U.S. Patent No. 5,981,940 was not amended and one of the original claims filed. Claim 1 as granted and as pending in

the present application recites “a screw . . . which can be turned in the pick-up shaft.” Claim 1 has been deemed to be in possession of the Applicants since it has not been rejected based on Section 112, first paragraph. Furthermore, citing *In re Wertheim*, 541 F.2d 257 (CCPA 1976), MPEP § 2163 I.A. states that “[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed.” Accordingly, Applicants possessed the invention of “a screw . . . which can be turned in the pick-up shaft.” One of ordinary skill would understand that such screw rotation inherently results in movement of the screw along a particular direction. Furthermore, since claim 1 recites that the screw is in the pick-up shaft, one of ordinary skill would understand that the movement of the screw will result in insertion of the screw within the pick-up shaft. One of ordinary skill would understand from claim 1 that the recited screw is an actuating element since claim 1 explicitly recites “a screw being the actuating element.” Thus, one of ordinary skill would understand that the Applicants also possessed a variation of the invention of claim 1 where a screw, moves and is inserted into the pick-up shaft. It follows that if Applicants possessed the invention of a screw that moves and is inserted into a pick-up shaft, then they must also possess the invention of claim 19 that recites an actuating element that is inserted into an opening and its relative movement causes a slit to radially spread open. Since Applicants possessed the invention of claim 19, as evidenced by original claim 1, the rejection is improper and should be withdrawn.

Further evidence that Applicants possessed the invention of claim 19 is found in the final paragraph of Applicants’ disclosure which states:

It is understood that the form of the invention described herewith are to be

taken as preferred embodiments and that various changes in the shape, size and arrangement of parts may be resorted to, without departing from the spirit of the invention or the scope of the claims.

This paragraph shows that Applicants possessed inventions that were not limited to the embodiments disclosed in the specification. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1345 (Fed. Cir. 2001). When the statements of the last paragraph are taken into account with the above arguments, it is clear that Applicants possessed the invention of claim 19.

On a related matter, the Office Action continually asserts that Applicants invention regards a turning into operation. This assertion is short sighted. It is well known that a screw as described in Applicants' patent moves in a helical manner in that it turns and moves/translates in a particular direction. Accordingly, Applicants possessed the concept of moving/translating an actuating element, such as a screw, and are not limited to a turning into operation.

**G. 35 U.S.C. § 251**

**1. Declaration**

Claims 1-38 were rejected under 35 U.S.C. § 251 because the reissue oath/declaration failed to identify at least one error which is relied upon to support the reissue application. In view of the reasons stated above in Section D, the rejection is overcome and should be withdrawn.

**2. New Matter**

Claims 19 and 25-29 were rejected under 35 U.S.C. § 251 as being based on new matter. In particular, the recitation of "an actuating element" which is inserted

into an opening and movement of the actuating element causes a slit to radially open, has been deemed new matter. Applicants traverse this rejection in that claim 19 does not specifically state that mere insertion will cause the slit to radially spread open. Claim 19 recites that there is a movement by the actuating element that causes a slit to radially spread open. As mentioned above in Sections E and F, the original specification describes an embodiment of the claimed invention where rotational movement of the screw causes the screw to move and be inserted into an opening that results in a slit radially spreading open. Since there is support for the claim language in the original specification, the rejection is improper and should be withdrawn.

On a related matter, note that the above argument should in no way be construed as preventing claim 19 from covering the situation where mere insertion of an actuating element causes a slit to radially spread open since the claims may cover embodiments not disclosed in the specification. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

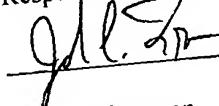
## CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-38 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next

Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at

(312) 321-4200.

Respectfully submitted,



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